

Attorney Docket No.: RU-0115
Inventors: Anderson et al.
Serial No.: 09/744,002
Filing Date: August 2, 2001
Page 5

REMARKS

Claim 12 is pending in the instant application. Claim 12 has been rejected and amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

I. Rejection of Claims Under 35 U.S.C. § 102

Claim 12 remains rejected under 35 U.S.C. § 102(b) as being anticipated by the University of Texas at Galveston campus as evidenced by Mumenthaler et al. (*J. Mol. Biol.* (1995) 254:465-480) and an e-mail solicited by the Examiner from Dr. Werner Braun (August 15, 2005). It is suggested that the University of Texas at Galveston campus comprised a computer, an NMR facility which had a spectrometer, data collection device, and computer algorithms to analyze the NMR spectra and determine the tertiary structure of proteins including the NOAH program for automated assignment of NOESY spectra, as well as laboratories for expressing proteins, access to the Wisconsin programs which can parse target polynucleotides, and internet access to the Protein Data Bank and the DALI web server. It is suggested that the elements of the claim not found in Mumenthaler are met by the e-mail from Dr. Braun. The Examiner suggests that Dr. Braun notes that UTMB had a laboratory that could express proteins in 1995, internet access to the protein databank at Brookhaven National Laboratory, and a computer algorithm capable of determining 3D structural homology between the known and unknown proteins as discussed in his e-mail. The Examiner suggests that the public use of the claimed elements at the University of Texas at Galveston in combination with the teachings of Mumenthaler et al.

Attorney Docket No.: RU-0115
Inventors: Anderson et al.
Serial No.: 09/744,002
Filing Date: August 2, 2001
Page 6

anticipates the present invention. It is further suggested that the addition of the term "comprising" to the claim does not invoke any particular relationship between the elements as there is no requirement that they are in the same building, same lab or owned by the same person. The Examiner suggests that Applicants' entire argument rests on the notion that "integrated" requires some particular relationship; however, no such relationship is required by the claim. Applicants respectfully disagree with this rejection.

As indicated in Applicants' response filed January 23, 2006, the e-mail by Dr. Braun merely makes note that the elements missing from Mumenthaler were in existence somewhere on the University of Texas at Galveston campus or at Brookhaven National Laboratory. However, neither Mumenthaler nor Dr. Braun teach or suggest combining the essential elements of the claim in an integrated system for deducing gene function from 3D structural analysis. In contrast, Applicants disclose the integration of the elements of the instant claim into a dedicated laboratory to rapidly determine the biochemical function of a protein or protein domain of unknown function. Accordingly, in an earnest effort to clarify the relationship between the elements of claim 12, Applicants have amended this claim to indicate that the elements are integrated into a dedicated laboratory. Support for this amendment is found at page 27 under section G. entitled "Integration into a Large-Scale High-Throughput 'Engine' for Structural and Functional Analysis of Hundreds of Human Genes", wherein a dedicated laboratory containing the claimed elements and staffed with artisans skilled in the relevant art is disclosed for determining the 3D structure of unknown protein

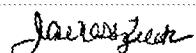
Attorney Docket No.: RU-0115
Inventors: Anderson et al.
Serial No.: 09/744,002
Filing Date: August 2, 2001
Page 7

domains. In so far as the e-mail by Dr. Braun and Mumenthaler et al. fail to teach or suggest integration of the claimed elements into a dedicated laboratory, these references cannot be held to anticipate the present invention in accordance with the requirements set forth under 35 U.S.C. § 102(b). Withdrawal of this rejection is therefore respectfully requested.

II. Conclusion

The Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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